

Accordingly, the amendment does not raise new issues requiring further search or consideration, results in cancellation of a rejected claim, and places this application in condition for allowance or, at least, in better form for appeal. Accordingly, upon entry of the foregoing amendments, claims 1-4 and 8-15 will be pending, and favorable reconsideration is respectfully requested.

There have been various grounds of formal (35 USC 112, second paragraph) rejections applied against amended claims 2, 4, 10, 15 and 16. These rejections are respectfully traversed for the following reasons.

Claim 2 is considered indefinite in view of the phrase "or a ground product thereof" since it is considered unclear how that phrase differs from "grounds left after coffee extract is prepared."

It is respectfully submitted that the Examiner has misconstrued the meaning and intent of the first quoted phrase above, as used in claim 2. Specifically, what is intended by claim 2 (and indeed, what claim 2 actually states) is that the starting raw material in the process of claim 1, i.e., the "extraction residue of roasted coffee beans" is grounds left after coffee extract is prepared from roasted coffee beans, where the roasted coffee beans (which are extracted) are either unground roasted coffee beans or ground roasted coffee beans. In other words, what is stated in claim 2 is that extraction residue used in the process of claim 1, can be the coffee-grounds which remain after a coffee extract has been recovered by a usual method from "the ground product of" roasted coffee beans or from unground roasted coffee beans. 

Accordingly, claim 2 is not indefinite and is not inconsistent with the disclosure on page 2, lines 9-19.

Therefore, this basis for rejection is respectfully traversed.

Claim 4 is considered indefinite because there are allegedly no units associated with the claimed range. Applicant respectfully disagrees.

Line 2 of claim 4, specifically refers to a "weight ratio" and line 4 states that this (weight ratio) is from 10/1 to 1/100. There are no specific units associated with the ratio, however, the claim o/c makes clear that the ratio is based on weight of the respective components.

Accordingly, this rejection is respectfully traversed.

Claim 10 is considered indefinite because of the phrase "growth nutrients effective for the growth of said yeast." NO

It is not particularly clear why the examiner considers that one of ordinary skill in the art of culture fermentation of yeasts, including wine yeasts, a process which has existed for tens of centuries, would not understand the metes and bounds of "growth nutrients effective for the growth of ... yeast." The examples certainly exemplify suitable and effective growth nutrients. For example, in Example 1 (see page 5) growth nutrients included sources of potassium and phosphorus (i.e., KH_2PO_4) and nitrogen and sulfur (i.e., $(\text{NH}_4)_2\text{SO}_4$) and magnesium (i.e., MgSO_4).

It is not believed that specific additional evidence to support the "argument" made by Applicant is necessary. Nevertheless, for the sake of expediting prosecution, but without intending to alter the scope of claim 10, the phrase "effective for the growth of said yeast" has been deleted from claim 10.

Accordingly, this basis for rejection is respectfully traversed.

Claim 15 is considered indefinite because the scope of the phrase "the residue remaining ... in the manufacture of instant coffee" is unknown.

Applicant respectfully disagrees.

According to claim 15, the extraction residue is the residue remaining after recovering coffee extract from roasted coffee beans used in the manufacture of instant coffee. While the scope of this claim may be broad, it is not indefinite. One skilled in the art would not require any special knowledge or need to undertake any experimentation to know whether or not any particular extraction residue was obtained from the manufacture of instant coffee.

Again, the composition of the residue is not what is important to carry out the present invention. The person of skill in the art need not know the composition of the residue to know that the residue was obtained after recovering coffee extract from roasted coffee beans in the manufacture of instant coffee.

Accordingly, the rejection of claim 15 is respectfully traversed.

In addition, however, for added clarity and to more closely conform to the subject matter Applicant regards as his invention, claim 15 is amended to define the "residue" as "coffee-grounds."

Finally, claim 16 is considered indefinite because the scope of the phrases "substantially devoid of coffee extract" and "a coffee like aroma" is unknown.

Applicant respectfully disagrees.

While it is believed that the scopes of these phrases are not indefinite since one skilled in the art would understand whether an extract is devoid or substantially devoid of coffee extract and whether a liquid has a coffee-like aroma (i.e., smells like coffee), nevertheless, to expedite prosecution, claim 16 is deleted.

For the above reasons, all of the formal grounds of rejection under 35 USC 112, second paragraph, are respectfully traversed and/or avoided.

Claims 8 and 9 are rejected under 35 USC 102(b) as anticipated by Papazian for the reasons of record. The Examiner further urges, in the case of claim 9, that the recitation of wine yeast would not change the final product, especially in the absence of recitation of ethanol level.

This rejection is respectfully traversed for the following reasons.

Claim 8 is directed to the alcoholic coffee drink obtained by the process of claim 1. Claim 1 describes a process which utilizes an extraction residue of roasted coffee beans.

As described in the specification of this application the extraction residue is essentially the waste product remaining after the coffee essence is removed from the coffee beans by extraction. As such, for example, the extraction residue is totally different from the coffee obtained from freshly ground beans, or "cold extract" of coffee essence, as contemplated by Parazian. In neither case, does Parazian provide a recipe or instructions which utilizes an extraction residue of roasted coffee beans, as opposed to the extract itself.

Therefore, the product resulting from the claimed method, using a uniquely different starting material, will necessarily be different.

Furthermore, in view of amended claim 1, from which claim 8 depends, as well as claim 9, the yeast which is used in the fermentation is a wine yeast. Although the Examiner urges that there is no difference in the product resulting from the yeast used in the fermentation, Applicant cannot agree.

A coffee wine is not a coffee beer. The alcohol content is not the only difference between a beer and a wine. Flavor, appearance, smell, are all differences between beers and wines and between coffee-flavored wine and coffee-flavored beer (or, conversely, wine-flavored coffee and beer-flavored coffee). *opinion*

Accordingly, it is respectfully submitted that since Papazian does not disclose (or even suggest) a coffee wine, the rejection of claims 8 and 9 as anticipated by Papazian, is clearly erroneous and should be withdrawn.

Of course, Parazian also does not disclose or suggest adding a saccharide to the extraction residue before fermenting, which step in the process will also lead to differences in the claimed end product. For this additional reason, claims 8 and 9 are not anticipated by Papazian.

Accordingly, it is respectfully submitted that the coffee beer drink as generally described would not and could not be an anticipation of the coffee wine drink as defined in claims 8 and 9.

Claims 1 to 4, 7-10 and 12-16 are rejected under 35 USC 103(a) as unpatentable over Papazian in view of Rizzi, et al, U.S. 5,008,125.

According to this rejection, Rizzi, et al teach the use of defatted spent coffee grounds to absorb bitter coffee flavors and burnt coffee aromas, and then adding the absorbent to roasted ground coffee. The spent coffee is considered to be cheap, unadulterating and tasteless. Therefore, according to the rejection, it would have been obvious to produce the alcoholic coffee drink of Papazian using coffee produced by the coffee process of Rizzi et al because alcoholic beverage producers have traditionally added a wide variety of flavors, including coffee, to produce drinks with novel flavors and tastes. The Examiner has also cited to *In re Levin*, 84 USPQ 232, as supporting the rejection.

Applicant disagrees and traverses this rejection for the following reasons.

First, considering the Papazian literature reference, it is submitted that this author would diametrically be opposed to using the coffee composition disclosed by Riggi, et al. comprising roast ground coffee (preferably "low quality coffee or blends containing a low quality coffee where bitter flavors and burnt aromas are often undesirably strong" (col. 4, lines 27-30) and defatted spent coffee grounds (DFG's). The DFG's are spent coffee grounds that contain from zero to about 2% lipids and are extracted, defatted and dried coffee grounds.

As explained by the examiner, the DFG's are tasteless and inexpensive absorbents. The patentee does not teach using the DFG's as a source of a coffee drink but only to be mixed, in small amounts with roast coffee grounds (i.e., weight ratio of roast ground coffee to DFG's between from about 5:1 to about 40:1, col. 7, lines 50-53).

20%
Accordingly, it is clear that one of ordinary skill in the art would not have been motivated by the disclosure of Riggi, et al, to use the Riggi, et al DFG's alone or DFG plus roasted coffee grounds as the starting material to produce the beer flavored coffee drinks of Papazian.

Conversely, nothing in the disclosure of Papazian (using the highest quality coffee and brewing process) would lead the practitioner to select the Riggi, et al material as a source of coffee flavor for Papazian's coffee beer. It is not enough that the combination may be possible, there must be some motivation in either reference to make the combination. No such motivation exists in this case.

The fact remains that Papazian does not disclose the step of "adding a saccharide to an extraction residue of roasted coffee beans" nor the subsequent step of fermenting the resulting mixture in the presence of yeast for brewing alcoholic beverages. It goes without saying that Papazian is totally silent concerning a process for producing a coffee wine using a wine yeast, as currently claimed.

In any case, as noted above, Rizzi et al includes no teaching which remotely suggests using DFG's as a raw material for alcoholic fermentation. According to Rizzi et al, the DFG's have substantially no coffee flavor, i.e., are tasteless. Accordingly, what motivation could possibly be found to use the DFG's as a starting material in a fermentation process for producing an alcoholic coffee drink? Clearly, the answer must be that there is no motivation to be found.

While it might be possible to make an argument that the use of the brewed coffee drink obtained from the mixture of DFG with roasted coffee ground and obtained by brewing using conventional coffee makers (see col. 9, lines 3-5) could be used as the coffee extract or essence for production of Papazian's coffee-flavored beer, there is absolutely no motivation or suggestion to use the DFG, per se, as a raw material for alcoholic fermentation.

As such, it is respectfully submitted that the Examiner is incorrect in suggesting that it would have been obvious to produce alcoholic coffee drinks of the primary reference using coffee produced by the coffee process of Rizzi et al, merely because "alcoholic beverage producers have traditionally added a wide variety of flavors, including coffee, to produce drinks with novel flavors and tastes." Even if true, this is not evidence pertinent to the present case.

The *In re Lavin* decision does not require a different conclusion. As noted by the language quoted by the Examiner, this case is discussing claims to a recipe or formula, whereas the rejected claims 1-4, 7 and 10-16 are directed to a process, while claims 8 and 9 are directed to a coffee wine drink, which, by virtue of the fermentation step applied to the mixture of saccharide, extraction residue and wine yeast, necessarily result in an interaction of the starting components. *UC*

Moreover, absent the citation of a specific "recipe or formula" of a coffee wine drink, there is no basis for concluding that the claimed product (by process) would have been obvious (or for applicant to make a comparison to such prior art). Again, nothing in the disclosure of Papazian suggests a recipe or formula for a coffee wine (which is not a coffee beer).

Accordingly, it is respectfully submitted that the subject matters of claims 1-4, 7 and 10-14, as now amended, would not have been *prima facie* obvious to the person of ordinary skill in the art at the time the present invention was made. Therefore, the rejection based on the disclosure of Papazian in view of Riggi et al is respectfully traversed.

Claim 11 is separately rejected as unpatentably obvious over the above combination, in further view of Suzuki, US 3,845,220.

This rejection is respectfully traversed for the following reasons.

First, the additional disclosure of Suzuki (relied on for teaching addition of enzyme to modify foaming properties of a coffee carbonated beverage) does not obviate the deficiencies of the primary combination of Papazian and Riggi et al.

The disclosure of using an enzyme as an antifoaming agent can hardly be said to be relevant to the disclosure of Papazian.

First, the foaming problem address by Suzuki involves foaming of a carbonated liquid beverage when the beverage is dispensed into a glass from a pressurized vessel and not foaming during fermentation. Papazian certainly is not concerned with and does not teach or suggest, adding carbonated water to a coffee flavored beverage.

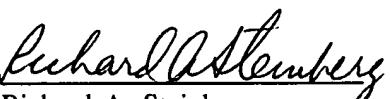
In this regard, it is considered instructive to note that Suzuki recognizes the different factors of foam producing and foam stabilization in a beer and in a carbonated beverage, e.g., Coca-Cola™ (see, e.g., col 2, lines 43-70). The Suzuki disclosure is concerned with the latter, not the former.

In the process of the present invention, the addition of hydrolase enzyme, as recited in claim 11, is for the purpose of hydrolyzing polysaccharides, proteins and the like in coffee-grounds. This is explained on page 3, lines 14-17, of the specification. The inventor explains that the function of the hydrolase treatment is to facilitate the assimilation of yeast by the coffee-grounds. Therefore, the function of the hydrolase treatment in the present invention is for a clearly different purpose than the enzyme treatment taught by Suzuki.

Accordingly, the rejection of claim 11 is respectfully traversed.

Withdrawal of the final rejection and favorable reconsideration and passage of the subject application to issue with claims 1-4, and 8-15, as amended, is earnestly solicited.

Respectfully submitted,

by 
Richard A. Steinberg
Attorney for Applicant
Reg. No. 26,588

SHERMAN & SHALLOWAY
P.O. Box 788
Alexandria, Virginia 22313
(703) 549-2282